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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/736,150	12/15/2003	Osamu Nagai	13712	3663
7590		11/14/2005	EXAMINER	
ORUM & ROTH		BURCH, MELODY M		
53 W. JACKSON BLVD		ART UNIT		
CHICAGO, IL 60604		PAPER NUMBER		
		3683		

DATE MAILED: 11/14/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/736,150

Applicant(s)

NAGAI, OSAMU

Examiner

Melody M. Burch

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 August 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 8/25/05 has been entered.

Claim Objections

2. Claim 7 is objected to because of the following informalities:
in line 2 of claim 7 the phrase "the one hydraulic shock absorber" should be changed to --the first hydraulic shock absorber-- to maintain consistency with amended claim 1 language.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent 5797594 to Sekine et al. in view of JP-6441495 (JP'495).

Re: claims 1, 2, 13, and 14. Sekine et al. show in figure 1 a hydraulic shock

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absorbing apparatus of a vehicle comprising: a compression side damping force generating structure for mainly generating a compression side damping force is provided in one hydraulic shock absorber, the one hydraulic shock absorber having a vehicle body side tube 2 and a wheel side tube shown surrounding tube 2 near the bottom of tube 2 which are slidably fitted to each other; a damper having a damper cylinder 8,11 and 8,11,19 in another perspective and a piston rod 18 in which a piston slidable within the damper cylinder is mountable to a leading end portion thereof, and structured such that the damper cylinder is mountable to an inner side of the wheel side tube via intermediate element 3 and the piston rod is mountable to an inner side of the vehicle body side tube via intervening element 9; a piston rod side oil chamber 8a and a piston side oil chamber 8b sectioned within the damper cylinder by the piston, an oil reservoir chamber 10 disposed in an outer periphery of the damper cylinder; and two oil passages 20,21 provided in the piston, a compression side damping valve 23 being provided in one oil passage, and a check valve 22 closing during compression and opening during expansion being provided in the other oil passage, and wherein a volume compensating oil passage 19a communicating the piston rod side oil chamber with the oil reservoir chamber is provided.

Sekine et al. describe the invention substantially as set forth above, but is silent as to having one of the shock absorbers at right and left sides of a wheel with an expansion side damping force generating structure for mainly generating an expansion side damping force being provided in another hydraulic shock absorber.

JP'495 teaches in pgs 1-2 of the description of the related art section of the instant specification the use of having shock absorbers at both sides of a wheel with one absorber providing the expansion side damping force generating apparatus and the other of the other of the absorbers providing the compression side damping force generating apparatus.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the shock absorber arrangement of Sekine et al. to have included one of the shock absorbers on both sides of a wheel, as taught by JP'495, in order to provide a means of effectively damping both expansion and compression strokes for a wheel to improve the feel of the ride.

Re: claims 3 and 4. Sekine et al., as modified, teach in figure 2 of Sekine et al. the limitation wherein a bypass oil passage 44 communicating the oil chambers in both sides of the piston is disposed in the piston rod of each of the hydraulic shock absorbers, and a damping force adjusting valve 28a is disposed in the bypass oil passage.

Re: claims 5-8. Sekine et al., as modified, teach in figure 2 of Sekine et al. the limitation wherein the oil passage 19 of the one hydraulic shock absorber is disposed in a side wall 19 in the other perspective of the damper cylinder.

Re: claims 9-12. Sekine et al., as modified, teach in figure 2 of Sekine et al. the limitation wherein the oil passage 19 for compensating the volume of the respective piston rod of the one hydraulic shock absorber is disposed in a guide member 19 for guiding the piston rod 18.

Response to Arguments

5. Applicant's arguments filed 8/25/05 have been fully considered but they are not persuasive.

Applicant argues that the concept of one absorber providing compression damping and the other absorber providing expansion damping is nowhere in the reference. Examiner maintains that the claims were subject to a 103 rejection and that in a 103 rejection, the references should not be attacked individually. Sekine, as modified, teaches the use of a shock absorbing system in which one absorber provides compression damping and the other absorber provides expansion damping. Sekine describes the claimed absorber structure and JP'495 teaches the presence of one shock absorber on each side of a wheel. It is reiterated that it is the combination of Sekine in view of JP'495 that teaches the invention.

Applicant argues that it is not explained where the exclusive compression damping on the one side and expansion damping on the other side can be found. Examiner notes that the claim language does not recite that the compression damping is exclusive on one side and the expansion damping on the other side. The absence of the term "exclusive" along with the use of the open-ended transitional term "comprising" both indicate that the claims do not preclude both compression and expansion damping in the absorbers on either side of the wheel. Applicant's suggestion that the one or the other of the compression/expansion valving structures would have to be eliminated to arrive at the presently claimed invention is incorrect in light of the broad recitation of the

invention including the open-ended term "comprising" and the absence of the argued term "exclusive" as discussed above.

Applicant argues that the disk valve is mistaken to be a check valve. Examiner maintains that, as broadly recited, a disk valve may be considered as a check valve since it allows fluid flow in one direction and blocks fluid flow in another direction.

Finally, Applicant argues that element 19a is not a volume compensating oil passage. Examiner maintains that since passage 19a is a passage that is opened based on the operation of element 19b that communicates oil passage 8a with oil passage 10. When element 19b allows fluid flow between chambers 8 and 10 there is volume compensation. Therefore, element 19a is properly considered a volume compensating oil passage.

Conclusion

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Melody M. Burch whose telephone number is 571-272-7114. The examiner can normally be reached on Monday-Friday (6:30 AM-3:00 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James McClellan can be reached on 571-272-6786. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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November 4, 2005

Melodey M. Burch
11/4/05